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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,250	02/02/2004	Brian W. Moroney	BLD920030008US1	9447

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DUFT BORNSSEN & FISHMAN, LLP
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EXAMINER

MILIA, MARK R

ART UNIT	PAPER NUMBER
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2625

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11/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/770,250	Applicant(s) MORONEY ET AL.	
	Examiner Mark R. Milia	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/30/08 has been entered. Currently, claims 1-6 and 8-13 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1 and 8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 8-13 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium.

Claims 8-13, while defining software, which is in essence a computer program, does not define a “computer-readable medium” and is thus non-statutory for that reasons. Software, or a computer program, can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the software on “computer-readable medium”, provided support for such can be found in the specification, in order to make the claim statutory.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorp et al. (US 2004/0252319) in view of U.S. Patent No. 6,236,450 to Ogura.

Regarding claim 1, Gorp discloses a method of reprinting at least one page of a printed document, the method comprising: printing a print job on a printer to generate the printed document (see Fig. 2 **16** and paragraph 31), determining that at least one page of the printed document includes an error (see paragraphs 44 and 59-60, at any time during processing the document an error is detected, the system may divert the

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document for inspection), instructing a user to load the printed document into an input bin of a print merge device (see paragraph 34).

Gorp does not disclose expressly instructing a user to load the printed document into an inserter tray on the printer, processing each page of the printed document from the inserter tray on the printer to an output tray on the printer by: determining if the page includes the error, if the page includes the error, then discarding the page, reprinting the page from the print job to generate a new page, and sending the new page to the output tray; and if the page does not include the error, then sending the page to the output tray.

Ogura discloses determining that at least one page of a document includes an error (see column 8 line 55-column 9 line 3, system detects when the document gets jammed), instructing a user to load the document into an inserter tray on the printer (see column 8 line 61-column 9 line 10 and column 13 lines 9-15, an error message is displayed to the user instructing the user to remove all document and set them again in the input tray), processing each page of the document from the inserter tray on the printer to an output tray on the printer by: determining if the page includes the error (see column 9 line 23-column 10 line 28), if the page includes the error, then discarding the page, reprinting the page from the print job to generate a new page, and sending the new page to the output tray, and if the page does not include the error, then sending the page to the output tray (see column 9 line 23-column 10 line 28 and column 12 lines 49-60, references shows that during a copy procedure if the document being copied jams then all the pages of the document, those that were already copied and those that have not yet been copied, are placed back into the input tray/ADF and processing starts

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again with those pages that had already been copied going straight to the output bin and when the page or pages that jammed are determined then copying proceeds to ensure that the entire document has been copied properly without redundancies and without missing any pages).

Regarding claim 8, Gorp discloses a system for reprinting at least one page of a printed document, the system comprising: a printer configured to print a print job on a printer to generate the printed document (see Fig. 2 **16** and paragraph 31), software configured to determine that at least one page of the printed document includes an error (see paragraphs 44 and 59-60, at any time during processing the document an error is detected, the system may divert the document for inspection), a user interface configured to instruct a user to load the printed document into an input bin of a print merge device (see paragraph 34).

Gorp does not disclose expressly a user interface configured to instruct a user to load the printed document into an inserter tray on the printer, the software further configured to process each page of the printed document from the inserter tray on the printer to an output tray on the printer and determine if the page includes the error, the software, responsive to the page including the error, further configured to discard the page, reprint the page from the print job to generate a new page, and send the new page to the output tray, and the software, responsive to the page not including the error, further configured to send the page to the output tray.

Ogura discloses software configured to determine that at least one page of a document includes an error (see column 8 line 55-column 9 line 3, system detects when

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the document gets jammed), a user interface configured to instruct a user to load the printed document into an inserter tray on the printer (see column 8 line 61-column 9 line 10 and column 13 lines 9-15, an error message is displayed to the user instructing the user to remove all document and set them again in the input tray), the software further configured to process each page of the printed document from the inserter tray on the printer to an output tray on the printer and determine if the page includes the error (see column 9 line 23-column 10 line 28), the software, responsive to the page including the error, further configured to discard the page, reprint the page from the print job to generate a new page, and send the new page to the output tray, and the software, responsive to the page not including the error, further configured to send the page to the output tray (see column 9 line 23-column 10 line 28 and column 12 lines 49-60, references shows that during a copy procedure if the document being copied jams then all the pages of the document, those that were already copied and those that have not yet been copied, are placed back into the input tray/ADF and processing starts again with those pages that had already been copied going straight to the output bin and when the page or pages that jammed are determined then copying proceeds to ensure that the entire document has been copied properly without redundancies and without missing any pages).

KSR analysis – Combining Prior Art Elements According to Known

Methods to Yield Predictable Results

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to utilize the method of gathering the entire document and reloading the

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document into an input tray, after an error is detected, and processing the document to send pages that were correctly processed prior to the error to an output bin and to process pages that were not yet printed and send the pages to the output bin to properly print or copy a document, as described by Ogura, to replace just printing the pages that are determined not to be printed after an error is detected, as describe by Gorp. Replacing the entire document ensures that the document will not contain the page in which the error was detected and thereby eliminate the wasting of time and resources. It would have been obvious to a person of ordinary skill in the art when presented with the two prior art references of Gorp and Ogura to arrive at the invention set forth in claims 1 and 8.

Therefore, it would have been obvious to combine Ogura with Gorp to obtain the invention as specified in claims 1 and 8.

Regarding claims 2 and 9, Gorp further discloses wherein determining that the at least one page of the printed document includes the error further comprises querying the user as to whether an updated copy of the printed document is available (see paragraphs 29, 35-36, and 58-60, if a collation error is detected it is determined if re-printing is necessary and possible and if so the portion or page is re-printed and if not then the entire document is re-printed).

Regarding claims 3 and 10, Gorp further discloses if the updated copy of the printed document is available, then automatically identifying the at least one page having the error (see paragraphs 29, 35-36, and 58-60, during collation each portion of

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the document, pages of the document, are verified based on a data file 2 to ensure correct page order and integrity, an error can automatically be detected and corrected), if the updated copy of the document is not available, then allowing the user to identify the at least one page having the error (see paragraph 59, occurrence of errors can be diverted for inspection by a user to handle the error in the proper manner).

Regarding claims 4 and 11, Gorp further discloses determining whether the error exists (see paragraphs 35-36 and 58-60) and notifying the user of the error (see paragraphs 44 and 57).

Regarding claims 5 and 13, Gorp further discloses wherein the error includes an update to the print job after printing the print job (see paragraphs 29-30, 33-36, and 60, if a collation error is detected it is determined if re-printing is necessary and possible and if so the portion or page is re-printed and if not then the entire document is re-printed).

Regarding claims 6 and 12, Ogura further discloses wherein the error includes a printer jam (see column 8 lines 55-60).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571)272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached at (571) 272-7437. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia
Examiner
Art Unit 2625

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Examiner, Art Unit 2625

/David K Moore/
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